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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/801,157 03/07/01 JOSEL

H RDID0089DUS

EXAMINER

HM12/0814

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PSH G

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/801,157

Applicant(s)  
Josel et al.

Examiner  
Grace Hsu

Art Unit  
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 7, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-8 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**






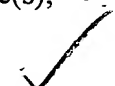




***Please Note:*** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Examiner at [Jyothsna.Venkat@uspto.gov](mailto:Jyothsna.Venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election of Species***

1. This application is a divisional application of 08/776,190, which is 371 National Phase Application of PCT/EP95/02915, International Filing Date: July 24, 1995 contains claims directed to patentably distinct species of the claimed invention.
2. Applicants are required to further elect a species for each of the following patentably distinct Species A-K as identified below that pertains to the claimed methods:

<u>Species</u>	<u>Claim Nos.</u>	<u>Species Type as Generically Defined:</u>
(1) A	1-8	<p>what type of conjugate as identified by generic chemical core structure; and a single compound species of the aforementioned generic structure; and</p> <p>the identification of the specific types of monomeric units, i.e., nucleotide(s), nucleotide analogues and amino acids that form the aforementioned conjugate and associated reactive side or protecting groups associated therewith by chemical name and/or chemical structure;</p>

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(2)	B	1-8	type of carrier; 	
(3)	C	1-8	means of linking monomeric units, which form a carrier, i.e. how is it linked, what type of linking group moiety, bonds, etc.;	
(4)	D	1-8	what markers or indicators determine the predetermined positions that the carrier is introduced;	
(5)	E	1-8	types of monomer(s) unit(s) used in the claimed process;	
(6)	F	1-8	types of hapten molecule(s);	
(7)	G	1-8	types of marker groups;	
(8)	H	1-8	types of solid phase binding groups;	
(9)	I	1-8	what specific linkers, bonds, etc. are the means used to link each of the components units that form the conjugate(s) of the claimed invention and are any specific types of linkers used for the connectivity between specific types of units;	
(10)	J	3	types of reactive side groups;	
(11)	K	2, 6, 7	specific types of primary amino protective groups, i.e., specific acid labile or acid stable groups;	

Each of the species encompassed by the claimed invention represent patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action.


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**For this response to be complete and for search purposes, applicants should provide the chemical structure of each elected species, wherein each specific chemical formula substituents of each of the above-identified elected species are defined either by picture or by expressing the species in terms of the variables of the formula.**

*Conclusion*

3. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 5:30 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jyothsna Venkat, Ph.D., may be reached at (703) 308-2439. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

  
DR. JYOTHSNA VENKAT PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 600

Grace C. Hsu, Ph.D., J.D.

August 10, 2001